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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,769	09/30/2003	Nathanael F. Ehrich	RSW920030073US1	4444

7590 12/14/2005  
Gerald R. Woods  
IBM Corporation  
T81/062  
PO Box 12195  
Research Triangle Park, NC 27709

EXAMINER
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HUYNH, THU V

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/674,769

Applicant(s)

EHRICH ET AL.

Examiner

Thu V. Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09/30/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to communications: IDS and application filed on 09/30/03.
2. Claims 1-19 are pending in the case. Claims 1, 13, 18-19 are independent claims.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 09/30/03 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Specification***

4. The disclosure is objected to because of the following informalities:

**Regarding specification page 1, line 5,** co-pending application number is missing.

**Regarding specification page 4, line 13,** the U.S. patent number of related application serial number 09/504,209 is missing. The US Patent Number 6,681,380 should be used for the related application.

**Regarding specification page 5, line 10,** "U.S. Pat. No. \_\_\_\_\_ (serial number 09/442,015, filed Nov. 17, 1999)" should be replaced with "U.S. Patent Application Number 09/442,015, filed Nov. 17, 1999".

Appropriate correction is required.

***Claim Objections***

5. Claims 2-12 and 14-17 are objected to because of the following informalities: these claim recite “the method according to Claim . . .”. The word “Claim” should be replaced with “claim” (without capital letter C). Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

**Regarding claims 1-17**, the language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S. C. 101.

In this case, claims 1-17 recite steps of a method that can be done by a person as a mental step and/or using pencil and paper. These claims’ limitations are not explicitly directed toward steps being implemented on a computer, computer readable medium, or other statutory device.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2178

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**9. Claims 1-4, 6-12 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by**

**Adams et al., US 6,457,030 B1, filed 01/99, patented 09/24/02.**

**Regarding independent claim 1**, Adams teaches the steps of:

- receiving a request for content (Adams, col.5, lines 59-60; col.7, lines 52-58; server receiving a request for a web page (HTML document) from a client's pervasive device);
- locating a template for the requested content, wherein the template specifies a plurality of alternative views of a component that forms a portion of the content (Adams, col.5, lines 59-67; col.9, line 37 – col.10, line 26; locating HTML template 40 (fig.5B) for the requested content, wherein the template specifies many of alternative views (fig.5B, alternative images 44a, 44b, 44c, 46a, 46b, 46c) for different type of pervasive computer device, so that one of alternative images 44a, 44b, 44c is selected for replacing image 30 in HTML file of fig.5A. Similarly, one of alternative images 46a, 46b, 46c is selected for replacing image 32 in HTML file of fig.5A);
- evaluating one or more factors to determine an evaluation result, wherein the determined evaluation result corresponds to a particular one of the specified alternative views (Adam, col.6, lines 35-47; col.10, lines 11-19; evaluating the display capabilities of the pervasive device requesting the web page to decide one of alternative images should be used for the replacing); and

- using the particular one of the specified alternative views for the portion of the content (Adam, col.9, lines 54-58; col.10, lines 11-26; replacing image 30 in the HTML file in fig.5A with the selected alternative image and displaying the web page with the selected alternative image via pervasive computing device requesting the web page).

**Regarding claim 2**, which is dependent on claim 1, Adams teaches the request is received from a client and further comprising the step of returning a response to the client, wherein the response includes the particular one of the specified alternative views (Adams, col.9, lines 54-58; col.10, lines 1-26; server receives the request for a web page (HTML document) from a client's pervasive device; selecting one of alternative image for replacing image 30 in the requested web page and providing the modified requested web page for displaying in client's pervasive computer device).

**Regarding claim 3**, which is dependent on claim 1, Adams teaches the requested content is a particular Web page and the template is a Web page template (Adams, figures 5A and 5B; a particular web page (fig.5A, HTML document) is requested by the client's pervasive computing device. The template 40 is a web page template (fig.5B, XML document) that specifies syntax for selectable alternative images).

**Regarding claim 4**, which is dependent on claim 1, Adams teaches the template is specified in a markup language document (Adams, fig.5B, the template 40 is an XML template).

**Regarding claim 6**, which is dependent on claim 1, Adams teaches using the determined evaluation result to identify the particular one of the specified alternative view (Adams, col.10, lines 11-19; evaluating the display capabilities of the pervasive computing device requesting the web page to decide one of alternative images should be used to replace the image 30 in the HTML file of fig.5A).

**Regarding claim 7**, which is dependent on claim 4, Adams teaches each of the alternative views is specified as a child element of a particular parent element, wherein each child element has as a value its associated alternative view (Adams, fig.5B, alternative images is specified as child element 44a, 44b, 44c of a particular parent element "<RDF:LI>", wherein each child element has a value of "BYTES" associated with the alternative view).

**Regarding claim 8**, which is dependent on claim 1, Adams teaches the template specifies alternative views for a plurality of components and wherein the evaluating and using steps apply to each of the specified components (Adams, col.10, lines 2-26; template specifies alternative views for many components, such as images 30 and 32 in HTML file of fig.5A. One of alternative images 44a, 44b, 44c is selected for replacing image 30 in HTML file of fig.5A based upon display capabilities of the pervasive computer device requesting the web page. Similarly one of alternative images 46a, 46b, 46c is selected for replacing image 30 in HTML file of fig.5A).

**Regarding claim 9**, which is dependent on claim 2, Adams teaches omitting, from the response, the specification of the alternative views which were not selected by the evaluating step (Adams, figures 5A and 5B; col.10, lines 2-26; selecting one of alternative images (for example 44a) to replace the image 30 in the HTML file of fig.5A, leave out the alternative images which were not selected).

**Regarding claim 10**, which is dependent on claim 7, Adams teaches omitting, from the response, the particular parent element and the child elements which were not selected by the evaluating step (Adams, figures 5A and 5B, selecting one of alternative images (for example 44a) to replace the image 30 in the HTML file of fig.5A, leave out the parent element “<RDF:LI>” and alternative images which were not selected).

**Regarding claim 11**, which is dependent on claim 1, Adams teaches substituting the selected alternative view for the specification of the plurality of alternative views (Adams, fig.5B; col.10, lines 14-19; substituting the selected alternative view (for example 44a) for other alternative views).

**Regarding claim 12**, which is dependent on claim 3, Adams teaches using selected alternative view to generate a version of the particular web page reflects the one or more evaluated factors (Adams, col.6, lines 36-47; col.8, line 45 – col.9, line 34; col.9, lines 55-58; col.10, line 11-26; modifying the requested web page based on display capabilities of the pervasive computer device).

**Regarding independent claim 18**, teaches the steps of:

- means for receiving a client request for a particular web page (Adams, col.5, lines 59-60; col.7, lines 52-58; server receiving a request for a web page (HTML document) from a client's pervasive device);
- means for locating a template for the particular web page, responsive to the means for receiving the client request, wherein the template specifies a plurality of alternative views of a component that forms a portion of particular web page along with an associated selection identifier for each of the specified alternative views (Adams, figures 5A and 5B; col.5, lines 59-67; col.9, line 37 – col.10, line 26; locating HTML template 40 (fig.5B) for the requested web page, wherein the template specifies many of alternative views 44a, 44b, 44c for different type of pervasive computer device, so that one of alternative images 44a, 44b, 44c is selected for replacing image 30 in HTML file of fig.5A. Each alternative view having an associated selection identifier, such as "HIEGHT", "WIDTH", "COLOR", "BYTES" parameter);
- evaluating one or more factors to determine an evaluation result, wherein the determined evaluation result corresponds to a particular one of the selection identifiers, thereby selecting the associated one of the specified alternative views (Adam, col.6, lines 35-47; col.10, lines 11-19; evaluating the display capabilities of the pervasive device requesting the web page, such as "HIEGHT", "WIDTH", "COLOR", "BYTES" values of the display device to decide one of alternative images should be used for the replacing); and

Art Unit: 2178

- using the selected alternative views for the portion when generating the particular web page requested by the client (Adam, col.9, lines 54-58; col.10, lines 11-26; replacing image 30 in the HTML file in fig.5A with the selected alternative image and displaying the web page with the selected alternative image via pervasive computing device requesting the web page).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
12. **Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al., US 6,457,030 B1, filed 01/1999, patented 09/24/02 and in view of Kanevsky, US 6,300,947 B1, filed 07/98, patented 10/01.**

**Regarding claim 5**, which is dependent on claim 1, Adams teaches the template is specified in a scripting language and is embedded in a markup language document (Adams, col.10, lines 1-4, the template 40 is embedded in the HTML file of fig.5A via link 42; “http://foo.com/catalog.meta” includes in the third line of the HTML file of fig.5A). However, Adams does not explicitly disclose the template is specified in a scripting language.

Kanevsky teaches scripting instructions allow produce web pages that fit to a format of a display device (Kanevsky, col.8, lines 2-8).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined kanevsky’s teaching and Adams’ teaching to used script language in the template, since the combination would have provided the template in markup language as well as script language that includes instructions for produce web pages for client’s display device as Kanevsky disclosed.

**13. Claims 13-14, 16-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al., US 6,457,030 B1, filed 01/99, patented 09/24/02, and in view of Narin, US 6,966,034 B2, filed 01/01.**

**Regarding independent claim 13**, Adams teaches the steps of:

- determining that content is generated from a particular template, wherein the template specifies a plurality of alternative views of a component that forms a portion of the content and also specifies an associated selection identifier for each of the specified alternative views (Adams, figures 5A and 5B; col.5, lines 59-67; col.8, lines45-57; col.9, line 37 – col.10, line 26; determining that content is generated from template

file <http://foo.com/catalog.meta> (fig.5B), wherein the template specifies many of alternative views (fig.5B, alternative view 44a, 44b, 44c) of an image that is used to replace image 30 in the requested HTML file of fig.5A. The templates specifies associated selection identifier, such as BYTES parameter that describe characteristic of the alternative view);

- evaluating one or more factors to determine an evaluation result, wherein the determined evaluation result corresponds to a particular one of the selection identifier, thereby selecting the associated one of the specified alternative views (Adam, col.6, lines 35-47; col.10, lines 11-19; evaluating the display capabilities of the pervasive device requesting the web page to decide one of alternative images should be used for the replacing); and
- using the particular one of the specified alternative views for the portion of the content (Adam, col.9, lines 54-58; col.10, lines 11-26; replacing image 30 in the HTML file in fig.5A with the selected alternative image and displaying the web page with the selected alternative image via pervasive computing device requesting the web page).

However, Adams does not explicitly disclose determining that content *should be* generated from a particular template.

Narin teaches information identifies the particular web browser and displaying capabilities of a computer device requesting a web page contains in user-agent request header and supplemental request header (Narin, col.6, lines 28-31; col.7, lines 21-29; col.8, lines 12-20). Server receives a request from a client for a web page (Narin, col.3, lines 1-6; col.8, lines 50-51).

Art Unit: 2178

Determining whether the supplemental request header and/or user-agent request header exist in the HTTP request (Narin, col.8, line 58 – col.9, line 6). If one of the headers does exist, selecting a best-suit web page to the existed header information for sending to the client (Narin, col.9, lines 3-45). If the request does not include any header, sending a generic response by sending entire web page as requested (Narin, col.9, lines 46-50).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Narin's teaching into Adams' teaching to determining that content should be generated from a particular template, since the combination would have provided a generic web page, such as the web page with image 30 and 32 when a client's pervasive computer device does not existed.

**Regarding claim 14**, which is dependent on claim 13, Adams teaches distributing the generated version of the content to a destination (Adams, fig. 1A, "display HTML file with modified element(s) via pervasive computing device).

**Regarding claim 16**, which is dependent on claim 13, Adams teaches embedding the selected alternative view into the generated version of the content (Adams, col.10, lines 11-26; the modified web page includes the alternative view (for example 44a) which replaced the image 30).

**Regarding claim 17**, which is dependent on claim 13, Adams teaches embedding an identifier of the selected alternative view into the generated version of the content (Adams, the

Art Unit: 2178

modified web page includes an identifier, such as the alternative view (for example 44a) which replaced the image 30).

**Claim 19** is for a computer program product embodied on computer readable media (Adams, col.4, lines 51-66; col.5, lines 26-41) performing the method of claim 13 and is rejected under the same rationale.

**14. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams in view of Narin as applied to claim 13 above, and further in view of Beranek, US 6,226,642 B1, filed 09/97, patented 05/01.**

**Regarding claim 15**, which is dependent on claim 13, Adams does not explicitly teach storing the generated version of the content in a repository.

Beranek teaches “after the Web page has been modified, the modified page is preferably stored back in the cache at step 271 in order that it may be reused if and when the user desires to revisit the page at a subsequent time” (Beranek, col.12, lines 31-35).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Beranek’s teaching into Adams’ teaching to storing the modified web page for an alternative view in cache, since the combination would have reused the modified web page if and when the user desires to revisit the page at a subsequent time as Beranek disclosed.

### ***Conclusion***

**15. The prior art made of record and not relied upon is considered pertinent to applicant's**

Art Unit: 2178

disclosure.

Wodarz et al., US 5,999,912, filed 05/97, teaches dynamic advertising scheduling display, and tracking.

Brown et al., US 5,887,133, filed 01/1997, teaches system and method modifying documents sent over a communication network.

Blumberg, US 6,708,309 B1, filed 03/99, teaches method and system for viewing scalable documents.

Sanders, US 6,938,077 B2, filed 11/01, teaches client version advertisement service for overriding default client version properties.

Takata, US 6,119,136, filed 08/97, teaches Manuscript text composition system featuring a parameter table for specifying template parameters and characters.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V. Huynh whose telephone number is (571) 272-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Thu V. Huynh', written in a cursive style.

Thu V. Huynh  
November 28, 2005